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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/070,831	04/30/1998	ASIT DAN	Y0998-137	4859
7590	10/06/2004		EXAMINER	
Gail H Zarick INTELLECTUAL PROPERTY LAW IBM CORPORATION PO BOX 218 YORKTOWN HEIGHTS, NY 10598			BROWN, RUEBEN M	
			ART UNIT	PAPER NUMBER
			2611	
			DATE MAILED: 10/06/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/070,831	DAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Reuben M. Brown	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 10 and 41-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10 and 41-61 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Considering claim 10, the instant claim recites, "wherein events control which rules in said library are applied to said presentation" and "testing each rule in the library for each selected event". These two requirements appear to be contradictory because if, "each rule in the library is

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tested for each selected event”, then it does not follow that the rules are also selected “depending upon the selected events”.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 41-45, 48-51 & 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Stack, (U.S. Pat # 5,815,717).

Considering claim 41, the claimed method of modifying previously generated presentation documents comprising creating a set of rules based upon user input is met by Stack, (Abstract; col. 5, lines 45-55; col. 12, lines 65-67 & col. 13, lines 7-15). Stack discloses that a user input 14 controls the rules that are applied to objects 16, which read on the claimed presentation documents.

The claimed selecting a previously generated presentation document to be modified, automatically modifying without user intervention, document based upon the rules to modify the

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document and outputting the modified presentation document is met by Stack, (col. 5, lines 40-55; col. 9, lines 49-65 & col. 10, lines 57-67).

Considering claims 42-45, Stack teaches changing the contents, temporal order, spatial layout, and attributes of the presentation document, (col 8, lines 46-67; col. 9, lines 49-67; col. 13, lines 16-25 & col. 14,lines 41-52).

Considering claims 48 & 54, the documents in Stack may be static components, (col. 10, lines 10-30).

Considering claims 49-51, the claimed method steps of modifying presentation documents that corresponds with subject matter mentioned above in the rejection of claim 41, are likewise treated. As for the further recitation that the documents are expanded, the claimed feature is broad enough reads on material being pasted or added to the original document and is taught by Stack, (col. 9, lines 49-67).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 46-47, 52-53 & 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stack, in view of Throckmorton, (U.S. pat # 5,818,441).

Considering claims 46-47, 52-53 & 59-60, Stack does not explicitly teach that the modified documents may be continuous media including audio/video components. Throckmorton teaches editing video content; (Abstract; col. 2, lines 55-67; col. 3, lines 45-65; col. 4, lines 1-50 & Fig. 2). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Stack by also modifying audio/video data, for the desirable advantage of providing a wider range of document processing for the user.

Considering claims 55-57, the claimed method steps of modifying presentation documents that corresponds with subject matter mentioned above in the rejection of claim 41, are likewise treated. As for the further recitation that at least two documents are merged, Stack does not specifically disclose such a feature. However, Throckmorton, which is in the same field of endeavor teaches merging at least two documents, Abstract; col. 3, lines 45-67; col. 4, lines 20-60. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Stack with the teachings of Throckmorton merging at least two documents at least for the desirable purpose of creating an enhanced multimedia document.

Considering claim 58, Throckmorton teaches that multiple documents may be simultaneously displayed, (col. 3, lines 50-67).

Considering claim 61, in both Stack & Throckmorton, the documents may be static.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Murrow, Shimizu Teaches editing a plurality of documents based upon a set of rules.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)

**Or:**

(703) 746-6861 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399. The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
CHRIS GRANT  
PRIMARY EXAMINER